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Remarks:

Reconsideration of the application is requested.

Claims 1-7 remain in the application.

In item 2 on page 2 of the Office action, claims 1-3, 5, and 7 have been rejected as being fully anticipated by Sugiyama (U.S. Patent No. 5,445,076) under 35 U.S.C. § 102.

As will be explained below, it is believed that the claims were patentable over the cited art in their original form and the claims have, therefore, not been amended to overcome the references.

Before discussing the prior art in detail, it is believed that a brief review of the invention as claimed, would be helpful.

Claim 1 calls for, *inter alia*:

a mounting support for mounting the sheet transport cylinder so that a rotational axis of the sheet transport cylinder is adjustable from a first axial position, which corresponds to a given printing-material thickness, to a second axial position.

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It is noted that there are two types of cylinders in printing presses. First, there are ink transport cylinders. Such cylinders include form cylinders and blanket cylinders. Secondly, there are sheet transport cylinders. Such cylinders include impression cylinders, and drums provided between the impression cylinders.

Furthermore, it is noted that claim 1 of the instant application is directed to a sheet-transport cylinder and not to an ink transport cylinder.

The Sugiyama et al. reference discloses a blanket cylinder (32) (column 4, line 13). The blanket cylinder (32) is an ink transport cylinder and not a sheet transport cylinder. Sugiyama et al. disclose that the printing paper (60) is transported on the impression cylinder (33), not on the blanket cylinder (32) (Fig. 3). Instead, as mentioned above, the blanket cylinder (32) is used to transport the ink, or the printing image formed of the printing ink (column 6, lines 14-19).

The reference does not show a mounting support for mounting the sheet transport cylinder so that a rotational axis of the sheet transport cylinder is adjustable from a first axial position, which corresponds to a given printing-material thickness, to a second axial position, as recited in claim 1

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of the instant application. The Sugiyama et al. reference discloses a blanket cylinder that is adjustable. Sugiyama et al. do not disclose a transport cylinder that is adjustable. This is contrary to the invention of the instant application, in which a sheet transport cylinder is adjustable from a first axial position to a second axial position.

Since claim 1 is believed to be allowable, dependent claims 2-3, 5, and 7 are believed to be allowable as well.

Furthermore, it is noted that Sugiyama et al. teach away from the object of claim 1 of the instant application because Sugiyama et al. teach that the sheet transport cylinder (impression cylinder 33) is fixed with respect to the left and right frames (35). Only the ink transport cylinder (blanket cylinder 32) is to be positioned in an adjustable manner (column 4, lines 29-34).

In item 4 on page 3 of the Office action, claims 1, 4, and 6 have been rejected as being obvious over Stein et al (U.S Patent No. 5,983,795) in view of Sugiyama (U.S Patent No. 5,445,076) under 35 U.S.C. § 103.

The Stein et al reference discloses a sheet transport cylinder (6).

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The combination of Stein et al. and Sugiyama et al. does not obviate the invention of the instant application as recited in claim 1, because a person of ordinary skill in the art knows that the adjusting device (eccentric bearing 37) disclosed by Sugiyama et al. is used for the adjustment of a blanket cylinder and not for the adjustment of a sheet transport cylinder. If a person of ordinary skill in the art were to use the adjusting device (eccentric bearing 37) of Sugiyama et al. in the invention disclosed by Stein et al., it would lead to an adjusting device used for adjusting the blanket cylinder (4) of Stein et al.. It would not lead to an adjusting device used for the transport cylinder (6) in Stein et al.. A person of ordinary skill in the art would follow to the teaching of Sugiyama et al., according to which the adjusting device is provided for the purpose of adjusting the position of a blanket cylinder. Therefore, the person of ordinary skill in the art would only consider providing the adjusting device of Sugiyama et al. for the purpose of adjusting the blanket cylinder (4) of Stein et al.

It is well settled that almost all claimed inventions are but novel combinations of old features. The courts have held in this context, however, that when "it is necessary to select elements of various teachings in order to form the claimed invention, we ascertain whether there is any suggestion or motivation in the prior art to make the selection made by the

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applicant". Interconnect Planning Corp. v. Feil, 227 USPQ 543, 551 (Fed. Cir. 1985) (emphasis added). "Obviousness can not be established by combining the teachings of the prior art to produce the claimed invention, absent some teaching, suggestion or incentive supporting the combination". In re Bond, 15 USPQ2d 1566, 1568 (Fed. Cir. 1990). "Under Section 103 teachings of references can be combined **only** if there is some suggestion or incentive to do so." ACS Hospital Systems, Inc. v. Montefiore Hospital et al., 221 USPQ 929, 933, 732 F.2d 1572 (Fed. Cir. 1984) (emphasis original). "Although a reference need not expressly teach that the disclosure contained therein should be combined with another, the showing of combinability, in whatever form, must nevertheless be **'clear and particular.'**" Winner Int'l Royalty Corp. v. Wang, 53 USPQ2d 1580, 1587, 202 F.3d 1340 (Fed. Cir. 2000) (emphasis added; citations omitted); Brown & Williamson Tobacco Corp. v. Philip Morris, Inc., 56 USPQ2d 1456, 1459 (Fed. Cir. Oct. 17, 2000). Applicants believe that there is no "clear and particular" teaching or suggestion in Sugiyama et al. to incorporate the features of Stein et al., and there is no teaching or suggestion in Stein et al. to incorporate the features of Sugiyama et al..

In establishing a *prima facie* case of obviousness, it is incumbent upon the Examiner to provide a reason why one of ordinary skill in the art would have been led to modify a

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prior art reference or to combine reference teachings to arrive at the claimed invention. Ex parte Clapp, 227 USPQ 972, 973 (Bd. Pat. App. & Int. 1985). To this end, the requisite motivation must stem from some teaching, suggestion, or inference in the prior art as a whole or from the knowledge generally available to one of ordinary skill in the art and not from the applicant's disclosure. See, for example, Uniroyal, Inc. v. Rudkin-Wiley Corp., 837 F.2d 1044, 1052, 5 USPQ2d 1434, 1439 (Fed. Cir. 1988), cert. den., 488 U.S. 825 (1988). The Examiner has not provided the requisite reason why one of ordinary skill in the art would have been led to modify Sugiyama et al. or Stein et al. or to combine Sugiyama et al.'s and Stein et al.'s teachings to arrive at the claimed present invention. Further, the Examiner has not shown the requisite motivation from some teaching, suggestion, or inference in Sugiyama et al. or Stein et al. or from knowledge available to those skilled in the art.

Applicants respectfully believe that any teaching, suggestion, or incentive possibly derived from the prior art is only present with hindsight judgment in view of the instant application. "It is impermissible, however, simply to engage in a hindsight reconstruction of the claimed invention, using the applicant's structure as a template and selecting elements from references to fill the gaps. . . . The references **themselves** must provide some teaching whereby the applicant's

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combination would have been obvious." In re Gorman, 18 USPQ2d 1885, 1888 (Fed. Cir. 1991) (emphasis added). Here, no such teaching is present in the cited references.

Since claim 1 is believed to be allowable, dependent claims 4 and 7 are believed to be allowable as well.

It is accordingly believed to be clear that none of the references, whether taken alone or in any combination, either show or suggest the features of claim 1. Claim 1 is, therefore, believed to be patentable over the art and since all of the dependent claims are ultimately dependent on claim 1, they are believed to be patentable as well.

In view of the foregoing, reconsideration and allowance of claims 1-7 are solicited.

In the event the Examiner should still find any of the claims to be unpatentable, counsel respectfully requests a telephone call so that, if possible, patentable language can be worked out.

If an extension of time for this paper is required, petition for extension is herewith made.

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Please charge any other fees which might be due with respect to Sections 1.16 and 1.17 to the Deposit Account of Lerner & Greenberg P.A., No. 12-1099.

Respectfully submitted,



For Applicant(s)

Alfred K. Dassler
52,794

AKD:cgm

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Lerner and Greenberg, P.A.
Post Office Box 2480
Hollywood, FL 33022-2480
Tel: (954) 925-1100
Fax: (954) 925-1101

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